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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/916,548

07/27/2001

Charles N. Harper

Serie 5684

8550

7590

05/18/2006

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Suite 1800  
1900 West Loop South  
Houston, TX 77027

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/916,548	<b>Applicant(s)</b> HARPER, CHARLES N.	
	<b>Examiner</b> OJO O. OYEBISI	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-6 and 16-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant recites the phrase “a contract valuation model”, “a financial position management model”, “a potential action valuation model” “a forecasting and planning model”, “a risk management model”, “a supply chain optimizer model”, and “a data delivery engine” which appear to be directed to computer program.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

**Claims 1-6 and 16-20** are therefore rejected where there is no indication that the

proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims **1-6 and 16-20** language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **1-6 and 16-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 16, the preamble of the claimed invention is directed to a system. However, the body of the claimed invention appears to be directed to a computer program/software. Thus it is not clear to the examiner what the applicant is trying to claim.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims cite different models i.e., "a contract valuation model", "a financial

position management model", "a potential action valuation model" "a forecasting and planning model", "a risk management model", "a supply chain optimizer model", for use in supporting business units decision-making. Thus since claims are interpreted in light of the specification, the examiner turns to the specification to find out detailed description of how these models are created or set up to carry out their intended use. However, there is not a single paragraph in the specification that describes how these aforementioned business models are set up or created to carry out/help shape their intended use. The applicant mentions in page 5 last paragraph of the present application that "the decision support system may comprise one or more elements such as a plurality of **interconnected models** wherein each model is operable for producing decision support. The plurality of interconnected models may comprise one or more models such as a contract valuation model for generating a value for existing and potential contracts for the electrical power, a potential action valuation model for generating a value for potential, predefined operation actions at a given production facility, a supply chain optimizer, a financial management model for use in managing ongoing use of financial positions related to energy commodities, a risk management model to allow entry of risk tolerance parameters, and a forecasting and planning model which supplies commodity forecast information to the contract valuation model and the financial position model." However, the applicant fails to describe how these interconnected models are set up, developed, created, or programmed to carry out the intended use. Thus the applicant's claim are very broad and vague, there is essentially no direction provided by the inventor.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al (Huang hereinafter, US PAT: 6,151,582).

**Re claims 1-20.** Huang discloses a decision support system for use in supporting business units including electricity energy production operations, electricity energy contract sales, management, and supplies (i.e., agile supply chain, see abstract). Huang further states a decision support system with server side that interfaces with one or more model engines that perform analytical processes on the data and transforms data either within a data space or between data spaces to determine requirements and make projections (see col.2 lines 30-50, see col.8 lines 25-40, see col.6 lines 25-65, also see the abstract). Huang does not explicitly disclose said system comprising: a contract valuation model for determining a value of existing and potential electrical energy contracts; a financial position management model for supporting purchases and sales of energy related financial instruments; a potential action valuation model for providing a value of potential short term electrical energy sales opportunities; a forecasting and planning model for providing forecasts of commodity prices utilized by said contract valuation model and said financial position model; a risk management

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model to provide risk tolerance factors for utilizing said forecasts; a supply chain optimizer model for optimizing supply routing and schedules; and a data delivery engine for supplying data to said contract valuation model, said financial position management model, said potential action valuation model, said forecasting and planning model, said risk management model, and said supply chain optimizer model. However, all the models disclosed hereinabove are old and well known and are frequently used in business management. Although, the applicant models are specifically applied to electrical energy related sectors. Nevertheless, these old and well-known models could be applied to any business sectors that is in need of decision support system. Further, Huang discloses a decision support system with one or more model engines for the management of agile supply chain. Thus agile supply chain encompasses electrical energy sales, and it would have been obvious to one of ordinary skill in the art to incorporate the old and well known business management models stated supra into the decision support systems of Huang to perform analytical processes on the generated data to determine requirements and make projections.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

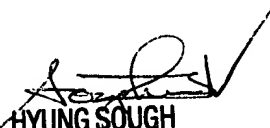
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
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